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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/852,666	05/07/1997	KIRIN K. CHADA	UMD-1.0-037C	7255

22249 7590 12/12/2001

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EXAMINER

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 12/12/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

08/852,666

Applicant(s)

CHADA ET AL.

Examiner

Chih-Min Kam

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 September 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 September 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 47-49.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 5. does NOT place the application in condition for allowance because: The claims do not overcome the rejection under 35 USC 112, first and second paragraphs.

Continuation of 7. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite because of the use of the term "fragment", it is not clear which fragment of HMGI is. In response, applicants argue that HMGI is the architectural component of the enhancosome, so it must interact with multiple proteins along with DNA, thus theoretically, any compound that binds to HMGI, regardless of what region it binds to, could disrupt this interaction, and further assert that a fragment represents any polypeptide with an amino acid sequence identical to any region of the HMGI protein. The argument is found not persuasive because "a fragment" can be broadly interpreted as a single amino acid and a compound binds an immobilized amino acid would not inhibit HMGI biological activity. Furthermore, the specification indicates disruption of the enhancosome assembly, by interfering either with protein-DNA or protein-protein interactions of HMGI proteins results in loss of transcriptional regulation and small molecules which possess a structure similar to the HMGI DNA-binding domain can inhibit HMGI biological function (page 53, lines 20-36). There is no evidence indicating a compound that binds any region of HMGI (any fragment of HMGI) would disrupt protein-DNA or protein-protein interaction, thus inhibit HMGI biological function. Even in the response, applicants indicate "theoretically" it could happen, but it is stated without supporting scientific data.

Claim 47 is also rejected under 35 U.S.C. 112, first paragraph because the specification does not identify the fragment of HMGI, unspecified fragments which do not contain functional domains such as DNA-binding domain and protein-binding domain would not accomplish the claimed method due to the reasons stated above. Regarding measuring the binding affinity and measuring the levels of reporter gene expression in the presence and absence of the candidate compound, applicants response (pages 5-6) is persuasive, thus rejection on this subject matter is withdrawn. Claims 48 and 49 are rejected because they depend from a rejected claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CMK
December 10, 2001

Christopher S. F. Low
CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
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